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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,881

03/31/2004

Montgomery M. Alger

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9066

23413 7590 01/17/2007
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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/815,881

Applicant(s)

ALGER ET AL.

Examiner

Tae H. Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 28-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "the polyamide" in line 2 of claim 15 lacks an antecedent basis and thus it is indefinite.

The recited "The method of claim 27" in claims 28-35 lacks an antecedent basis in claim 27 wherein "a composition" is claimed. Thus claims are indefinite.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 10-17, 19 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,908,964. Although the conflicting claims are not identical, they are not patentably distinct from each other because the first intimate blend of said patent meets the instant concentrate.

Claims 1, 3-7, 10-17, 19, 25, 27-30 and 33-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,627,701. Although the conflicting claims are not identical, they are not patentably distinct from each other because the first intimate blend of said patent meets the instant concentrate.

Claims 27-31 and 33-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,352,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examiner interprets claims 27-35 as composition claims and the intended thermoplastic composition has no probative value.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 10-14, 16, 17, 19, 20, 25, 27-31 and 33-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Laughner (US 5,262,476 or 5,270,386).

Laughner (US'476) teaches the instant method of mixing a polyphenylene ether concentrate with a blend of a polycarbonate and a polyester and a composition and a molded article thereof in abstract and examples and at col. 1, line 25 to col. 3, line 35. Dry blend and melt mixed concentrates are taught at col. 3, lines 13-24. Said concentrate comprises poly(phenylene ether) and other polymers, and one or two of said other polymers meet the instant additive absent further limitation. Also, a polymer having a higher melting point among said other polymers would meet the instant additives such as nucleating agents and/or anti-drip agents. With respect to amounts of components, the examiner's position is that overlapping range is anticipation.

Laughner (US'386) teaches the same throughout the patent except a blend of polycarbonate and polyester. Laughner (US'386) teaches employing a blend of a styrene copolymer and a polyphenylene ether instead.

The examiner interprets claims 28-31 and 33-35 as composition claims and the intended thermoplastic composition has no probative value.

Thus, the invention lacks novelty.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as obvious over Laughner (US 5,262,476 or 5,270,386).

Laughner also teach employing additional polymers such as polyolefin at col. 2, line 40, and thus use of said polyolefin in making a polyphenylene ether concentrate would be a *prima facie* obviousness since said polyolefin can be added either in the concentrate or in the final composition..

The instant invention further recites rubber impact modified polystyrene as the second and third thermoplastic, pelletized concentrate, blowing agent, polyolefin as a second polymer and other additives over Laughner. However, Laughner teaches employing rubber impact modified polystyrene in said concentrate at col. 1, line 30 and col. 10, line 50 to col. 11, line 11, and an additional impact modifier at col. 2, line 38. Blowing molding is taught at col. 3, lines 30-31, and thus use of a blowing agent is an obvious practice. Pelletized composition is taught at bottom of col. 28, and thus the pelletized concentrate would be an obvious practice since the word concentrate implies future use with other polymer(s), and thus easy storage and transportation would require pellets. Use of other additives is taught at col. 27, line 63 to col. 28, line 42, and thus employing said additives in polyphenylene ether concentrate would be obvious modification since said additives can be added either in the concentrate or in the final composition.

Thus, it would have been obvious to one skilled in the art at the time of invention to modify the teaching of Laughner to obtain the instant invention as reason given above absent showing otherwise.

Claims 27-29, 31 and 33-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bastiaens et al (US 6,353,050).

Bastiaens et al teach the instant composition in table 1 and claim 1. Adedeji et al teach the same in table 1.

The examiner interprets claims 28-31 and 33-35 as composition claims and the intended thermoplastic composition has no probative value.

Thus, the invention lacks novelty.

Claims 27-29, 31 and 33-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adedeji et al (US 6,350,804).

Bastiaens et al teach the instant composition in table 1 and claim 1.

The examiner interprets claims 28-31 and 33-35 as composition claims and the intended thermoplastic composition has no probative value.

Thus, the invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

Art Unit: 1714

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/January 8, 2007